

## ***REMARKS***

Reconsideration and allowance of this application are respectfully requested in light of the following remarks.

### ***THE TEMPLATE OF PARESCHI IS NOT THE SAME AS THE AD BOX DEFAULT TEMPLATE OR AD MASTER TEMPLATE OF THE PRESENT INVENTION***

Pareschi teaches a system and method that allows a user to define a process template using a Generalized Process Structure Grammar (“GPSG”). The process is a representation of work in which there are activities and documents that transition through a set of steps and states, respectively. Pareschi is teaching a process template for describing causally-dependent activities in which documents and tasks are duals of one another (Abstract; col.5, lines18- 67, TABLE 1). In Pareschi, both tasks and documents break down into sub-task and sub-documents. Pareschi is, in effect, teaching a new workflow definition approach that allows tasks to be performed concurrently by using a GPSG. Pareschi defines two types of rules: activity-based and document based to define dependencies between any of activities and documents.

The present claimed invention recites ad templates comprising Ad Box Default templates and Ad Master templates and an instance of an Ad Master comprises at least one Ad Box instance. The process template taught by Pareschi is not a data structure as is the Ad Master template and the Ad Box Default template of the present claimed invention. The templates of the present invention have business rules associated with entries therein which do not correspond to any teaching of Pareschi. Pareschi is not equivalent to the present invention because defining a process template using a GPSG does not use the same structure and does not perform the same function and does not achieve the same results as does customizing an Ad Box Default Template (which already has rules and roles associated with it) and placing instances thereof into an Ad Master Template instance (which already has rules and roles associated with it).

## ***SPECIFICATION***

The specification has been amended to insert the text of original claims 6 and 10, respectively, which are part of the original disclosure, to provide further support for ad template

means for specifying rules and roles as recited by present claims 1, 6, 10 and 20. No new matter has been added by this amendment to the specification.

### ***CLAIM REJECTIONS***

**A. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

**Office Action Position**

The Office Action alleges that claims 1, 6, 10, 12 and 20 recite “ad template means” or “ad template” for specifying company advertiser and ad publisher business rules. The specification, disclose (sic) template means or template for preparation and administration of ads but does not disclose template for specifying the role and rules for preparation and administration. The specification discloses means for specifying rules and roles, however does not teach template for specifying the rules and roles.

**Applicants’ Response**

Applicants respectfully traverse.

At the outset Applicants point out that in an amendment filed on July 15, 2004 Applicants amended claims 1, and 20 as agreed to in an Office Interview by Examiner, conducted on June 23, 2004, to recite the now-objected to term “ad template means”. The agreed to amendment of claims 1 and 20 necessitated the corresponding amendment of claims 6, 10 and 12 to recite “ad template means”.

At the outset Applicants further point out that claim 12 does not recite ad template means for specifying rules and roles but instead recites “... ad template means for preparation and administration of ads...” and the Examiner has admitted that the specification discloses template means or templates for preparation and administration of ads and the rejection of claim 12 should therefore be withdrawn.

In the context of this application great care was taken to use the term “specifying” rather than “defining” because rules and roles are defined in the database and are specified by, i.e., associated with, various ad templates (Ad Box Default templates and Ad Master templates), instances thereof, and respective entries and components thereof. Applicants note that this is well-known in the art of

databases to define rules and roles and the applicability of rules and the access privileges of roles by separately defining and storing in a database the rules and the applicability thereof as well as the role types and access privileges thereof. Further, it is well known to assign role types to users, and to specify the roles that have access to data by somehow associating the role with records or fields therein. A similar well-known paradigm applies to specifying the rules that apply to records and fields therein. However, this is only one way to specify rules and roles. There can be other ways. Applicants have disclosed this way as their best mode at the time their invention was made.

### **Roles**

With regard to specifying roles,

(1) FIG. 5B boxes 2011 and 2102, which are connected to box 2013, respectively disclose that when either an Ad Master Template or an Ad Master Instance is edited, deleted, and created, the role of agent associated with Ad Master Templates is likewise edited, deleted, and created as well as authorized and this is ad template means for specifying roles;

(2) FIG. 6 box 607 discloses that when an Ad Box is created input is required for specifying the agent role and this is ad template means for specifying roles;

(3) FIG. 7 box 711 discloses when an Ad Master is edited or deleted or a new Ad Master is started that input is required for specifying the agent role and this is ad template means for specifying roles;

(4) The database schema of FIG. 3 defines how a database stores specified role associations. For example, agents defined in AGENTS of FIG. 3B are specified for ADS (instances of Ad Boxes) 304, i.e., are associated with ADS 304, using AD\_AGT\_KEY and are similarly specified for AD\_MASTERS 303 via MAD\_COMP\_FK with COMPANIES 307 which associates a role of company database administration COM\_DBA\_NAME with an Ad Master instance. In addition company prepress administrators PRE\_ADMIN\_COMP, prepress administrators PREPRESS\_ADMIN, administrators ADMINS and super administrators SUPER\_ADMINS are all similarly specified using Ad Masters AD\_MASTERS 303 and associated therewith via COMPANIES 307. As one skilled in the art will realize, roles are not defined except by an administrator, i.e., someone with special access privileges. However, some role associations with instances of Ad Box default templates and Ad Masters can be specified by an Agent that is creating the instance.

(5) Original claim 10 is part of the original disclosure, discloses ad template means for specifying roles, and has been added to the text of the specification as further support for each of claims 1, 10 and 20 recitation of “ad template means for specifying ... roles”. Original claim 10 recited

“... said means for specifying company advertiser and ad publisher roles comprises:  
a plurality of roles for preparation and administration of ads, each of said plurality of roles being assumable by at least one of company advertiser personnel and ad publisher personnel, at least one of said plurality of roles being associated with each said Ad Box default template, and at least one of said plurality of roles being associated with each said Ad Master template; and  
database storing of said plurality of roles and the association of each said role with each said Ad Box default template and each said Ad Master template.”

(6) FIG. 26D illustrates specifying an agent for an instance of an Ad Box. FIG. 35B illustrates defining an Agent Admin for a company. FIG. 40 illustrates defining a new Super Admin.

Applicants assert at least all of the foregoing support the recitation by present claims 1, 10, 12 and 20 of ad template means for specifying at least one of company advertiser and ad publisher personnel roles to accomplish preparation and administration of ads for publication.

### **Rules**

With regard to specifying rules,

(1) FIG. 30-33 illustrates ad template means for specifying rules by using a screen for editing business rules associated with a named Ad Box template;

(2) FIG. 34 illustrates a screen for specifying global deadline rules that are associated with all Ad Box templates and [0017] discloses that these ... administrative deadline rules are incorporated into Ad Box and Ad Master templates stored in a ...database 500 ... these rules are completely customizable at any time during the operation of the system and method of the present invention and this is ad template means for specifying rules;

(3) FIG. 37 illustrates a screen for specifying a business rule that controls photo types used by a company in instances of Ad Box templates and this is ad template means for specifying rules;

(4) FIG. 38A-B illustrate screens for associating background images from a drop down list with an Ad Box template and this is ad template means for specifying rules;

(5) FIGs. 44A-C and 45A-C illustrate screens for editing template characteristics (which

are business rules associated with templates) and this is ad template means for specifying rules;

(6) [0108] of the specification discloses "...for gallery ads there will be stored one or more Ad Box and Ad Master templates embodying Company and Publisher business rules. ..." and this is ad template means for specifying rules;

(7) [0110] of the specification discloses "... A business rule associated with the corresponding Ad Master template determines the retention period for a given Ad Master. ..." and this is ad template means for specifying rules;

(8) [0132] of the specification discloses "An ad Master template is a layout and format template that captures both Company and Publisher rules and enforces these rules each time an Ad Master instance is created and edited. ..." and this is ad template means for specifying rules;

(9) The database schema of FIG. 3 defines how a database stores specified rule associations. For example, [0132] discloses "... an ad is prepared for publication by establishing ... business rules for the ad using an Ad Master template stored in the database table TEMPLATES 300. ..." and this is ad template means for specifying rules;

(10) Original claim 6 is part of the original disclosure, discloses ad template means for specifying rules, and has been added to the text of the specification as further support for each of claims 1, 6, and 20 recitation of "ad template means for specifying ... rules". Original claim 6 recited

"... said means for specifying company advertiser and ad publisher business rules to direct ad preparation and administration and provide administrative control by said system comprises:

a plurality of business rules governing preparation and administration of ads, each of said plurality of business rules being specified by at least one of a company advertiser and ad publisher, at least one of said plurality entries defined by said at least one default Ad Box template being associated with and controlled by at least one of said plurality of business rules, and each of said plurality of components defined by said at least one Ad Master template being associated with and controlled by at least one of said plurality of business rules; and

database storing of said at least one Ad Box default template comprising each of said plurality of entries and associated business rules;

database storing of said at least one Ad Master template comprising each of said plurality of components and associated business rules."

Applicants assert at least all of the foregoing support the recitation by present claims 1, 6, 10 and 20 of ad template means for specifying at least one of company advertiser and ad publisher

business rules to accomplish preparation and administration of ads for publication.

In view of the foregoing discussions and specification amendments, all of the claim rejections under 35 U.S.C. 112, first paragraph have been overcome and the rejections should be withdrawn.

**B. Claims 1- 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over “GMTI To Giveaway Rolex Watch at NEXPO 2000”, (hereinafter GMTI) in view of Pareschi et al., U.S. Patent No. 6,725,428, further in view of Gannett Media Technologies International “Gannett Media Technologies International to Exhibit at Seybold New York/Exhibit to feature Celebro Advertising Solutions and Digital Collections Multimedia Management System” <http://www.gmti.com/newsdetail.asp?newsTitle, April 16, 1999> (hereinafter Gannett)**

### **Claims 1-4**

#### **The Office Action Position**

The Office Action alleges that with regard to claims 1-4 GMTI teaches template means for preparation and administration of ads for publication by roles according to business rules by accepting advertisers’ data, placing the data into custom-designed ad templates and electronically delivering the ads for publication. The Office Action alleges that GMTI teaches database for storing ad templates and formatting ads for at least one ad delivery medium, citing page 1 of the reference. However, the Office Action also alleges that GMTI teaches that the service is being provided by Celebro.com database application services and Office Action admits that GMTI does not explicitly suggest that the ad template, publisher and advertiser rules and roles are stored in a database.

The Office Action further alleges that Gannett teaches providing advertiser the capability to control the design, scheduling, and content of their advertising working off a central server.

The Office Action then admits that GMTI does not explicitly teach template for specifying advertiser and publisher business rules and roles but that Pareschi teaches means for specifying rules and roles for a work process or task such as publishing papers based on a set of rules and roles and the use of a template (col. 5, lines 18-67; col. 6, lines 5-12, lines 58-67; col. 7 lines 1-67). The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention was made for GMTI to use Pareschi’s method/system of specifying roles and rules in GMTI’s preparation and administration of ads in order to specify the rules and roles of the advertisers and publishers. It would have been obvious for GMTI to specify the rules and roles of the advertisers and publishers, since the task or work requires a collaborative input of multiple

individuals or departments such as the advertisers and publisher for the preparation and administration of the ads, as taught in GMTI.

#### Applicants Response

Applicants respectfully traverse.

The Examiner alleges that GMTI teaches template means for preparation and administration of ads for publication by roles according to business rules. Applicants now provide an exact quote of the teaching of the GMTI reference cited by the examiner

“Celebro.com database application services provide the well-proven means to increase automotive and real estate advertising, while strengthening your relationship with those advertisers along the way. Celebro.com accepts advertiser data via the Internet, places it into custom-designed ad templates, and electronically delivers those ads to your newspaper-output ready-no proof required. All this is accomplished via the Internet.”(page 1, paragraph 4)

Nowhere in the GMTI reference, either at the cited location or anywhere else, does GMTI teach or suggest template means for preparation and administration of ads for publication *by roles according to business rules*. There is no mention, suggestion, hint or any other type of teaching of rules and roles much less ad template means for preparation and administration of ads for publication by roles according to business rules as alleged by the Examiner and recited by present claim 1. In fact, the Examiner has rejected present claims 1-24 under 35 U.S.C. 112, first paragraph on the basis that Applicants’ specification fails to describe in the specification in such a way as to reasonably convey to one skilled in the relevant that the inventors(s), at the time the application was filed, had possession of the claimed invention of

“...“ad template means” or “ad template” for specifying company advertiser and ad publisher business rules.” (page 2, paragraph 4 of the Office Action)

where, as pointed out above, Applicants have disclosed substantial ad template means for such company advertiser and ad publisher business rule and role specifying as opposed to the cited reference wherein there is not even a mention or a hint of a teaching of roles and rules and the reference even *teaches away* from any collaborative input of advertiser and publisher personnel by teaching

“Celebro.com accepts advertiser data ... places it into custom-designed ad templates, and electronically delivers those ads to your newspaper-output ready-**no proof required**”. (emphasis added), ((page 1, paragraph 4 of GMTI)

The lack of any teaching or suggestion of rules and roles by the GMTI reference negatives any motivation to modify the GMTI to include rules and roles, using Pareschi or any other reference. The custom-designed ad templates taught by GMTI receive advertiser data without any teaching of a role for placing of the advertiser data therein. In fact, the teaching of GMTI is that this placing of data is automatic and there is no teaching of ad template means for specifying company advertiser and ad publisher business rules for such placement. Without any teaching of rules and/or roles for any reason by GMTI, contrary to the allegation of the Office Action, it would not have been obvious to one of ordinary skill in the art at the time Applicants' invention was made for GMTI to use Pareschi's method/system of specifying roles and rules in GMTI's preparation and administration of ads in order to specify the rules and roles of the advertisers and publishers. Further, GMTI does not anywhere teach or suggest administration of ad preparation, as recited by claims 1-19. Therefore, absent Applicants' disclosure, there is no motivation to combine the GMTI and Pareschi references. Further, these references have nothing in common except the word "template" and GMTI uses "template" as an advertiser-specific data structure into which is placed advertiser data received over the Internet, and Pareschi uses "template" as a process framework that one constructs using a process grammar.

Further, as discussed above there is no motivation to combine these references and as alleged by the Office Action since GMTI even teaches away from collaborative input of multiple individuals or departments such as the advertisers and publisher for the preparation and administration of the ads.

The Office Action admits that GMTI does not suggest that the ad template, publisher and advertiser rules and roles are stored in a database, as recited by claim 1. Applicants again assert that GMTI does not anywhere teach or suggest rules and roles and therefore does not and cannot teach that something that is does not teach is stored in a database. Applicants also assert that neither GMTI nor Gannett suggest *a database for storing said ad templates comprising company advertiser and ad publisher business rules, personnel roles, and ads prepared and administered by said roles for publication according to said business rules* as recited by claim 1 and that it is not inherent that a custom-designed ad template be stored in a database in the teaching of Gannett. A simple file will do as the storage mechanism.



A reviewing court has stated that you have to have motivation to sustain a 35 U.S.C. 103(a) rejection. Absent Applicants' disclosure there is no motivation to combine either or both GMTI and Gannett with Pareschi. The court in *In re Sang Su Lee*, 277 F.3d 1338, (Fed. Cir. 2003) held that there must be some explicit motivation to modify a reference in the prior art itself and that an Applicant's invention cannot be used as a roadmap against applicant, as is being done by the Office Action in making this rejection. The court held that doing so is improper hindsight. This decision is in accord with the Board of Patent Appeals and Interferences decision in *Ex parte Levengood*, 28 U.S.P.Q. 2d 1300, 1302 (1993).

In view of the foregoing discussions, not only has the Office Action failed to disclose where in the reference the cited features are taught but has also failed to make out a *prima facie* case of obviousness because there is no motivation to combine GMTI with Pareschi since GMTI does not teach rules or roles, there is no database for storing a custom-designed ad template or such a template filled-in with data, either taught, suggested, or inherent in either the GMTI or Gannett references, and Pareschi does not remedy these deficiencies of either the GMTI or Gannett references or a combination thereof. Therefore, independent claim 1 is allowable, claims 2-19 dependent therefrom are allowable for at least this reason, and the rejections thereof should be withdrawn.

#### **Claim 2 recites in pertinent part**

“... wherein said database is a least one of networked, distributed and replicated.

None of the cited references teaches any database. At best, GMTI teaches that Celebro.com database application services accept advertiser data via the Internet and place it into custom-designed ad templates which are electronically delivered to your newspaper-output ready-no proof required.

Further, since the Office Action is silent regarding a rejection of claim 2 it is therefore assumed that claim 2 is allowable.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, the rejection of claim 2 should be withdrawn, and claim 2 is allowable. Claim 2 therefore has an independent basis for allowability.

#### **Claim 3**

##### **The Office Action Position**

The Office Action admits that GMTI does not explicitly teach ad template comprising a web browser but alleges that Gannett teaches Internet access supported for browser and that it would have

been obvious to one of ordinary skill in the art at the time of the invention for GMTI to access the ad template through the Internet using a browser in order to easily navigate the Web and access the data.

#### Applicants Response

Applicants respectfully traverse.

Claim 3 recites in pertinent part

“...said ad template means for preparation comprises a Web browser”

Neither of the cited references teaches ad template means comprising a web browser. At most, GMTI teaches that Celebro.com accepts advertiser data via the Internet and Gannett offers facilities for full Internet support and hosting and is a fully scaleable client server application running under Microsoft’s popular Windows NT operating system. None of these are teachings of ad template means comprising a web browser as recited by instant claim 3.

In view of the foregoing discussion, none of the cited references teaches or suggests the second limitation of instant claim 3. Thus, the Office Action has failed to make out a *prima facie* case of obviousness and the rejection should be withdrawn. Claim 3 is allowable and therefore has an independent basis for allowability.

#### Claims 5-10, 13-19

##### The Office Action Position

With regard to claims 5-10, 13-19, the Office Action alleges that GMTI as modified, teaches *inter alia* advertisers designing ads using templates.

The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time Applicants’ invention was made for GMTI to indicate the stage of preparation and administration using Pareschi’s instance in order for users to use the template to design their own ads, as in GMTI and select the content and design and to schedule the ads for publication as taught in Gannett.

#### Applicants’ Response

Applicants respectfully traverse.

Contrary to the allegation of the Office Action, GMTI, as modified by Pareschi, does not teach advertisers designing ads using templates. Pareschi teaches using a GPSG approach to define a *process template* by constructing a process grammar which specifies the lexicon of process objects

and wherein a *process instance* is any legal phrase generated from the process grammar, **neither of which process template and process instance is the same as or even equivalent to an Ad Box Default Template and/or an Ad Master Template as recited by instant claim 5.** Since the process template of Pareschi is not the same as either an Ad Master Template or an Ad Box Default Template, as recited by the present invention, it follows that instances of Pareschi's template cannot be the same and as instances of either the Ad Master Template or an instance of the Ad Box Default Template.

Claim 5 recites at least one Ad Box Default template for preparing an Ad Box instance of an ad for an individual item and at least one Ad Master template for preparing a layout of an Ad Master instance defining a plurality of components comprising at least one Ad Box instance. Further, providing Ad Box Default template and Ad Master template is not inherent to Celebro's placement of data in custom-designed ad templates as taught by GMTI.

While Gannett does teach controlling the design, scheduling and content of ads Gannett does not teach any kind of template. While GMTI teaches a custom-designed ad template, GMTI only teaches accepting advertiser data via the Internet and placing the accepted data into custom-designed ad templates and then delivering those ads to a newspaper-output ready-no proof required. That is, GMTI does not teach controlling the design, scheduling and content of ads. Since these two articles are separated in time by more than three years it is not clear that they are even describing the same product. Gannett is a press release dated 4-16-97 that describes, in two very brief and non-enabling paragraphs, a client server application hosted by Celebro. GMTI is a press release dated 6-1-00 that describes, in one very brief paragraph that Celebro has changed its name to Celebro.com and in another very brief and non-enabling paragraph that Celebro.com accepts advertiser data via the Internet, places it into custom-designed ad templates, and electronically delivers those ads to a newspaper-output ready-no proof required. Even assuming these two cited references are describing the same product, neither reference is enabling in that neither teaches what such a custom-designed ad template is or how one might implement such a custom-designed template or what it contains. The Examiner had to combine GMTI with Pareschi and allege that the combination taught an ad template, which, as explained above, it does not. Further, it is clear from GMTI that the user, at the time that the user sends data to Celebro.com, has no control over the design of the custom-designed template, unlike in the present invention in which the ad template is *inter alia* a means for specifying

company advertiser and ad publisher business rules to control preparation and administration of ads for publication, none of which is taught by GMTI

Contrary to the allegation of the Office Action, there is no teaching that an Ad Master and each Ad Box contained therein has a status for indicating its stage of preparation and administration in any of the cited references. Instant claim 5 (and claims 6-19, respectively dependent therefrom) recites a limitation of a status for indicating a stage of (1) preparation and (2) administration for both Ad Box instances and Ad Master instances, which is nowhere taught or suggested by any of the cited references. At most Pareschi teaches activity objects and document objects that have an internally maintained state feature which points to a time record of changes in state of the object, and Pareschi nowhere teaches or suggest that a document object is an instance of an Ad Box Default template or and instance of an Ad Master instance. An instance of a template is a process in Pareschi and an instance of a template in the present claimed invention is an Ad Box or and Ad Master comprising at least one Ad Box and these latter two instances are not process instances. They are not the same as argued above. Instances of templates as taught by Pareschi do not have a status. Pareschi only teaches that activity and document objects have a state which is not the same as an instance of a process template having a status.

### **Claim 10**

#### **Office Action Position**

The Office Action alleges GMTI as modified, teaches advertisers designing ads using templates and that Pareschi teaches specifying the rules and roles.

#### **Applicants' Response**

Applicants point out that the invention of present claim 10 recites “ad template means for specifying company advertiser and ad publisher roles” and that, as argued above, Pareschi only teaches a process template which is not the same as or equivalent to the present claimed ad template, Ad Box default template and the Ad Master template recited by the invention of claim 10. Nor does Pareschi teach ad template means for specifying company advertiser and ad publisher roles comprises

“a plurality of roles for preparation and administration of ads, each of said plurality of roles being assumable by at least one of company advertiser personnel and ad publisher personnel, at least one of said plurality of roles being associated with each said Ad Box default template, and at least one of said plurality of roles being

associated with each said Ad Master template; and database storing of said plurality of roles and the associating of each said role with each said Ad Box default template and with each said Ad Master template.” (as recited by claim 10)

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 10, claim 10 is allowable and claims 11- 12 dependent therefrom are allowable for at least this reason and the rejections thereof should be withdrawn. Therefore, claim 10 has an independent basis for allowability.

### **Claims 11 and 12**

#### **Office Action Position**

The Office Action admits that GMTI does not teach each of the roles perform at least one of creating, editing and database storing of ad box default template or ad master template, etc. The Office Action alleges that Pareschi teaches roles performing one of creating, editing and storing of template etc citing col. 9 line 50 to col. 10, line 63). Further, the Office Action provides as motivation for combining GMTI with Pareschi “in order to create the custom-designed ad template of GMTI.”

#### **Applicants’ Response**

Applicants’ repeat the argument above that there is no motivation to combine Pareschi with GMTI since GMTI nowhere teaches rules and roles and that GMTI nowhere teaches, suggests or even hints at any problem with creating the custom-designed ad templates of Celebro that would motivate combining GMTI with Pareschi therefor. In fact, combining GMTI with Pareschi would not accomplish creation of the custom-designed ad templates of Celebro. Pareschi would have to be combined with Celebro and there is certainly no motivation provided in any reference for such a combination. The law concerning obviousness does not extend to combining references which are not cited, e.g., Celebro.com.

Even assuming *arguendo* that the combination of GMTI with Pareschi is motivated for the purpose of creating the custom-designed ad templates of Celebro, Applicants’ repeat the argument above that Pareschi nowhere teaches an Ad Box Default template or an Ad Master Template or instances thereof and even if these structures are well known the combination of GMTI and Pareschi

does not magically transform the process template taught by Pareschi into an ad template or an Ad Box default template or an Ad Master template.

Further, at the cited location of col. 9, line 50 to col. 10, line 63, Pareschi teaches a collaborative document writing process which is not the same as and is not equivalent to roles performing at least one of

“...creation, editing and database storing of said at least one Ad Master template and associated business rules;  
creation editing, approval, setting said status, and database storing of Ad Box instances of said at least one Ad Box default template according to said associated business rules;  
creation, editing, sending to publisher, setting said status, and database storing of Ad Master instances of said at least one Ad Master template, said creating and editing accomplished by retrieving from said database and laying out said Ad Box instances in said Ad Master instances according to said associated business rules;  
retrieval from said database, review, rejection, approval sending to print and setting said status of said Ad Master Instances.” (as recited by claim 11)

That is, even assuming *arguendo* that there is motivation to combine GMTI with Pareschi, Pareschi's teaching of collaborative creation of a document is not the same as creating the templates for someone else to use to collaboratively create an ad.

Finally, there is no motivation for use Pareschi's method for specifying the roles to create the custom-designed ad template of GMTI as alleged by the Office Action because there is no problem identified that such a combination would solve, i.e., there is no motivation to combine these references and there has to be one other than you can use a reference to accomplish what another reference teaches. Furthermore, Pareschi does not teach roles for creating an ad template because Pareschi teaches defining a process template using a process grammar and a process template is not an ad template, as previously argued.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 11 and claim 12 dependent therefrom are allowable and the rejection thereof should be withdrawn. Therefore, claim 11 has an independent basis for allowability.

## **Claim 12**

### **Office Action Position**

The Office Action does not address the limitations of claim 12 in which at least one of said plurality of roles according to said rules accesses database-stored Ad Box default templates and database-stored Ad Master templates to create, edit and approve, set status and store in database Ad Box instances and Ad Master instances.

In view of the foregoing discussion, claim 12 is assumed to be allowed.

## **Claims 13-19**

The Office Action does not address the limitations of claims 13-19. Further, Applicants assert that none of the cited references teaches or suggests the subject matter of claim 13-19:

- (a) a component of an Ad Master Template comprises at least one filler box comprising a plurality of pre-determined entries (instant claim 13);
- (b) an Ad Box Template comprises at least one required entry (instant claim 14);
- (c) each of the plurality of entries of an Ad Box Template is selected from lead line, image, audio, video, automation, geographic location display, signal (sig) line, and ad body text (instant claim 15);
- (d) the plurality of entries of an Ad Box Template further comprises at least one optional entry (instant claims 16 and 18); and
- (e) the optional entry of an Ad Box Template comprises banner, first line of company data, second line of company data and dollar amount (instant claims 17 and 19).

Therefore, claim 13-19 are assumed to be allowed.

**C. Claims 20-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pareschi et al., U.S. Patent No. 6,725,428 in view of NAA® Presstime: NEXPO'97 Report, Presstime, <http://www.naa.org/prestime/97nexpo/nexad.ntml>, (hereinafter NAA). "GMTI To Giveaway Rolex Watch at NEXPO 2000", (hereinafter GMTI).**

### **Office Action Position**

The Office Action alleges that Pareschi teaches template for specifying business rules and roles and for preparation and administration of tasks such as publication, citing col. 5 lines 18-67, col. 6 lines 5-12, col. 7 lines 1-67) and that NAA teaches providing newspaper-supplied ad templates

permitting advertiser to create ads for print, audiotex and WWW by taking information from database and turn the text and photos into newspaper ads, choose a schedule and send the ads to newspapers' ad database. The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to specify the rules and roles of advertisers and publishers using Pareschi's system by putting advertisers in control of the design of the ads and to automatically transmit ads to the newspaper in order to reduce error, as taught by NAA (see page 4). Therefore, Office Action alleges that Pareschi as modified by NAA teaches the preparing and administering ads for publication by the specified roles and rules and storing the rules and roles in the ad template in a database and storing the prepared ads in a database.

#### Applicants' Response

Applicants respectfully traverse.

As argued above Pareschi does not anywhere teach a template for specifying business rules and roles of individuals for preparation and administration of tasks such as publication. Pareschi teaches defining a *process template* using GSPG by constructing a process grammar which specifies the lexicon of process objects (activity and document objects) and the rules to combine them. A process instance is any legal phrase generated from the process grammar during a simulation.

Even assuming *arguendo* that there is some other motivation to combine Pareschi with NAA, the process template taught by Pareschi cannot be transformed into an ad template thereby. Applicants allege that this is because a process is not an ad template as recited by the present claimed invention of claim 20. And, regardless of whether or not Pareschi teaches associating rules and roles with the process template, combining Pareschi with NAA does not transform Pareschi's process template (any legal phrase generated from the process grammar during a simulation) into an ad template (a data structure) in which rules and roles are specified and then stored as an ad template (a data structure) that includes said specified rules and roles in a database, as recited by claim 20.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to independent claim 20 and claim 20 and claims 21-24, dependent therefrom are allowable, and the rejection thereof should be withdrawn.

#### Claims 21 and 22

##### Office Action Position

The Office Action alleges the Pareschi as modified teaches ad template.



### Applicants' Response

Applicants respectfully traverse.

As argued repeatedly above, Pareschi teaches defining a process template using GPSG and does not teach any template that can transformed into an ad template. Therefore, even assuming *arguendo* that there is some motivation to combine Pareschi with NAA, doing so does not somehow magically transform a process template defined by a generalized process structure grammar into the ad template, Ad Box default template and the Ad Master template of the present claimed invention of claims 21 and 22 and storing said templates including said business rules and roles in a database (claim 21) and associating each entry in an Ad Box default template and each component of and Ad Master template with at least one business rule. Further, while Ad Box default templates and Ad Master templates are arguably obvious, associating business rules with entries and component respectively thereof is not obvious and the Examiner did not take Official Notice of this claimed association.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to claims 21 and 22 and claims 21 and 22 are allowable and claims 23-24, dependent therefrom are allowable, and the rejection thereof should be withdrawn. Claims 21 and 22 therefore have an independent basis for allowability.

### Claims 23-24

#### Office Action Position

The Office Action alleges that GMTI as modified teach each of the roles perform at least one of creating, editing and database storing of ad box default template or ad master template, etc.

Further, the Office Action alleges that Pareschi teaches roles performing tasks such as one of creating, editing and storing of template etc. citing col. 9, line 50 to col. 10, line 63) and it would have been obvious to one of ordinary skill in the art at the time of the invention to specify rule and roles for individuals performing tasks and for each role to perform at least one of the roles of creating, editing and database storing of Ad Box and associated rules, etc., in order to create the custom-designed ads.

### Applicants' Response

Applicants respectfully traverse.

First, since the Examiner has already addressed claim 22, it is assumed that the rejection is directed to claims 23-24.

Second, Applicants note that the Office Action has not alleged any modification of GMTI with respect to claims 23-24. Applicants assume that the Examiner meant NAA and not GMTI.

Third, Applicants note that the present claimed invention of claim 24 does not recite any role of creating, editing and database storing but recites that at least one of said plurality of roles performs these functions.

Further, Applicants note that claim 23 recites, in pertinent part,

“iii. associating at least one of said plurality of roles with each said Ad Box default template;  
iv. associating at least one of said plurality of roles with each said Ad Master template; and  
storing in a database said plurality of roles and said association of at least one of said plurality of roles with said Ad Box default template and said Ad Master template.”

NAA does not teach any of the foregoing limitations of claim 23. Further, as argued repeatedly above, Pareschi teaches defining a process template using a GPSG grammar does not anywhere teach or suggest an Ad Box default template or an Ad Master template and therefore modifying NAA with Pareschi does not achieve the claimed invention of claim 23.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 23, claim 23 is allowable and 24 dependent therefrom is allowable, and the rejections thereof should be withdrawn. Claim 23 therefore has an independent basis for allowability.

With regard to claim 24, even assuming *arguendo* that the combination of NAA with Pareschi and GMTI is motivated, Applicants’ repeat the argument above that Pareschi nowhere teaches an Ad Box Default template or an Ad Master Template or instances thereof and even if these structures are well known the combination of NAA and Pareschi and GMTI does not magically transform the process template taught by Pareschi into an ad template or an Ad Box default template or an Ad Master template.

Further, at the cited location of col. 9, line 50 to col. 10, line 63, Pareschi teaches a collaborative document writing process which is not the same as and is not equivalent to performing the steps of

“vi. creating, editing and storing in a database by said associated at least one of said plurality of roles of said at least one Ad Box default template and associated business rules;  
vii. creating, editing, and storing in a database by said associated at least one of said plurality of roles of said at least one Ad Master template and said associated business rules;  
viii. creating, editing, approving, setting said status, and storing in a database by said associated at least one of said plurality of roles of Ad Box instances of said at least one Ad Box default template in accordance with said associated business rules;  
...” (as recited by claim 24)

That is, even assuming *arguendo* that there is motivation to combine NAA with Pareschi, Pareschi’s teaching of collaborative creation of a document is not the same as creating the templates for someone else to use to collaboratively create an ad.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 24 and claim 24 is allowable and the rejection thereof should be withdrawn. Therefore, claim 24 has an independent basis for allowability.

**D. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over “GMTI To Giveaway ROLEX Watch at NEXPO 2000” (hereinafter GMTI) in view of Pareschi et al. U.S. Paten No. 6,725,428 further in view of Gannett Media Technologies International “Gannet Media Technologies International to Exhibit at Seybold New York/Exhibit to feature Celebro Advertising Solutions and Digital Collections Multimedia Management System” <http://www.gmti.com/newsdeail.asp?newsTitle, April 16, 1999> (hereinafter Gannett).**

#### Office Action Position

With regard to claim 25, the Office Action alleges *inter alia* that it would have been obvious to one of ordinary skill in the art at the time applicants’ invention was made for someone to specify the role and rule of GMTI ad publication using Pareschi’s input means for the ad to be designed by the advertiser and published by the publisher as disclosed in GMTI.

With regard to claim 26, the Office Action alleges that GMTI teaches a fully scaleable client server application running under Microsoft’s Window NT operation system.

#### Applicants’ Response

Applicants respectfully traverse.

As argued above with respect to claim 1, GMTI nowhere teaches, suggests or even hints at role and rule and therefore there is no motivation to combine GMTI with Pareschi to specify non-

existent role and rule.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 25 and claim 25 is allowable and claim 26 dependent therefrom is allowable for at least this reason and the rejections thereof should be withdrawn. Therefore, claim 25 has an independent basis for allowability.

Claim 26 recites in pertinent part

“...the communications network means is the Internet and said computer input means employs a Web browser”

Microsoft’s Windows NT operation system is not the Internet and assuming said computer input means is part of NT this computer input means is not a Web browser, it could be any type of input means including a dedicated GUI (graphical user interface).

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 26, claim 26 is allowable and the rejection thereof should be withdrawn. Therefore, claim 26 has an independent basis for allowability.

## *CONCLUSION*

For at least the above reasons, it is respectfully submitted that all rejections have been overcome and the present invention is in condition for allowance. A Notice of Allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas P. Pavelko', with a long horizontal line extending to the right.

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Date: May 3, 2005

TPP/NOW/att

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